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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,899	09/18/2003	Brian T. Worsham	25343/37:7	7026

32642 7590 08/30/2010

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EXAMINER	
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ART UNIT	**PAPER NUMBER**
3689	

MAIL DATE	DELIVERY MODE
08/30/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/665,899	WORSHAM ET AL.	
	Examiner	Art Unit	
	THUY-VI NGUYEN	3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 June 2010*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *19-35 and 37* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *19-35, 37* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *08/06/10*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/24/10 has been entered.

2. This is in response to the applicant's communication filed on 06/24/10 wherein:

Claims 19-35, 37 are currently pending;

Claims 19-20, 23, 25-26, 29-30, 32 have been amended;

Claims 1-18 and 36 have been cancelled;

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 32-35 and 37 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In accordance with In re Bilski, 88 USPQ2d 1385 (Fed.Cir. 2008) the **Machine -or-Transformation Test**, the claimed process must:

(1) be tied to a particular machine or apparatus (machine implemented); or

(2) particularly transform a particular article to a different state or thing.

A method claim that does not require machine implementation or does not cause a transformation will fail the test and should be rejected under § 101. However, the mere presence of a machine tie or transformation is not sufficient to pass the test. When a machine tie or transformation has been identified, it must be further determined that the tie is to a **particular** machine or the particular transformation is of a **particular** article. Additionally, the particular machine tie or particular transformation must meet two corollaries to pass the test for subject matter eligibility. First, the use of the particular machine or transformation of the particular article must impose a **meaningful limit** on the claim's scope. So, a machine tie in only a field-of-use limitation would not be sufficient.

Second, the use of the particular machine or the transformation of the particular article must involve **more than insignificant "extra-solution" activity**. If the machine or transformation is only present in a field-of-use limitation or in a step that is only insignificant "extra-solution" activity, the claim fails the Machine-or-Transformation test, despite the presence of a machine or a transformation in the claim.

With respect to claim 32, the claim language does not transform the underlying subject matter and the process is not tied to a particular machine nor is there a transformation. Even thought the preamble recites "a computer implemented method ....", however the process steps of claims such as "*generating…; selecting..; returning…; is not performed by a computer or* is not tied to a particular machine, and thus the claims are directed to nonstatutory subject matter.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims **19-24** (method), **25-31** (method), and **32-35 and 37** (method) are rejected under 35 U.S.C. 102(e) as anticipated by SKORSKI (US 2004/0012631).

As for independent claim 19, SKORSKI discloses a computer-implemented method of returning customized_information comprising:

a) generating by a computer a first view comprising a first plurality of attributes of a specific tangible object for a first venue by,

accessing at the computer a specific representation of the specific tangible object in a database comprising a computer readable storage medium, the specific representation including a plurality of attributes of the specific tangible object,

{see SKORSKI at least figures 1-2; pars. 0009, 0019, 0021-0022 discloses the distributor product's database (single database) stores the product/object, a plurality of attributes/*product information e.g. product name, product SKU numbers, one or more image files; text files; search keywords; price; taxes; shipping; sale or promotion etc* of

the specific tangible object (e.g. *veterinary product or orthopedic products*) *in a database*},

selecting from the plurality of attributes, the first plurality of attributes to be included in the first view using a first rule associate with the first venue

{see figures 1-2, pars. 0009-0010 wherein SKORSKI discloses "*display data (product information) according to selected criteria, and in different formats, according to the type of user that accesses information. In such manner, different populations of users can access different catalogs built from the same data*",

{and pars. 0021-0022; 0028-0029 wherein SKORSKI discloses as the patient accessing the online medical store for patients will *view product information displayed retail price*, *while the retailer physician's practice will see the same item at a different price*. This implies that the system applies rule to select the first plurality of attributes of a specific product/object for a patient user to view in a first view. For example: product information (first plurality of attributes) including *product SKU numbers, product name, product images, search and also a* particular *price* is determined based on the status of user e.g. a user is a patients are included in the first view},

generating a first view of the specific tangible object comprising plurality of attributes and transmitting the first view to the first venue,

{see pars. 0028-0029 for generating a first view (e.g. patient's view) for a specific tangible object/particular product. For example "*a patient accessing the online medical store (*first venue*) for patients will view product information and see a displayed retail price*. This implies that the first plurality of attributes of the specific product in a first

view is generated. For example: product information (first plurality of attributes) including *product SKU numbers, product name, product images, search and also a particular price* which is determined based on the status of user e.g. a user is a patients is showed to the patient user},

b) generating by a computer a second view comprising a second plurality of attributes of the same specific tangible object for a second venue by,

accessing at the computer the same specific representation of the same specific tangible object in the same database, the specific representation including the same plurality of attributes,

{see SKORSKI at least figures 1-2; pars. 0009, 0019, 0021-0022 discloses a plurality of attributes/*product information e.g. product name, product SKU numbers, one or more image files; text files; search keywords; price; taxes; shipping; sale or promotion etc* of the specific tangible object (e.g. *veterinary product or orthopedic products*) *in a database*},

selecting from the plurality of attributes, the second plurality of attributes to be included in the second view using a second rule associated with the second venue, wherein at least one attribute in the second plurality is not included in the first plurality,

{see pars. 0021-0022; 0028-0029 wherein SKORSKI inherently discloses using second rule since SKORSKI discloses different users (patient and retailer's physician) can see different price (attribute). The patient accessing the online medical store for patients will *view product information displayed retail price*, *while the retailer physician's practice will see the same item at a different price*. This implies that the system applies

rule to select the second plurality of attributes of a specific product/object for retailer physician to view. For example: product information (second plurality of attributes) including *product SKU numbers, product name, product images, search and also a* particular *price* is determined based on the status of user e.g. a user is a retailer physician's practice are included in the second view}. This also implies that at least one attribute (price) in the second plurality is not included in the first plurality since the product information/plurality of attributes are viewed the same, except for the different price associated with user status, e.g. patient user or retailer physician.

generating the second view of the same specific tangible object comprising the second plurality of attributes and transmitting the second view to the second venue,

{see pars. 0028-0029 wherein SKORSKI inherently discloses generating a second view (e.g. retailer's view) for a specific tangible object/particular product. For example "*a patient accessing the online medical store (*venue*) for patients will view product information and see a displayed retail price*. This implies that the system applies rule to select the second plurality of attributes of a specific product/object for retailer physician to view. For example: product information (second plurality of attributes) including *product SKU numbers, product name, product images, search and also a* particular *price* is determined based on the status of user e.g. a user is a retailer physician's practice are included in the second view}.

Note that the general concept of generating a view (or display or web page) of the object based on a rule (first rule, second rule) associated with the first venue,

second venue (first user, second user) is inherently included in the teachings of SKORSKI as shown on pars. [0009, 0016, 0022-0024, and Figs. 2-3].

As for dep. claim 20, which discloses the receiving attribute to the specific product or object and storing the attribute in the computer readable storage medium, this inherently included in SKORSKI, see figure 1-3, at least pars. 0019-0020, 0028-0029.

As for dep. claim 21, which describes the specific function of the object or data stored in the database, i.e. an automobile, this is non-functional descriptive material (NFDM) and has no patentable weight. Furthermore, this is inherently taught in SKORSKI as shown in the catalog product database; pars. 0003-0005.

As for dep. claim 22, which discloses the venues a re websites accessible by users at remote locations, this is taught in SKORSKI figures 1-3, pars. 0018-0019, 0021, 0023.

As for dep. claim 24, which discloses the first view includes the first value and excludes the second value, and the second view include the second value excluded the first value, this is inherently taught in SKORSKI see figure 2, pars. 0028-0029 implies that the system applies rule to select the plurality of attributes of a specific product/object for a user to view. For example: product information (plurality of attributes) including *product SKU numbers, product name, product images, search* are included in both view (e.g. retailer physician view and patient view) *also a price*. The product information/plurality of attributes are viewed the same, except for the different price associated with user status, e.g. patient user or retailer physician. Therefore,

SKORSKI teach the first view (patient's view) includes the first value (e.g. price for patient customer) and excludes the second value (price for retailer), and the second view (retailer view) includes the second value (retailer's price) in compliance with the rule.

As for independent method claim 25, which is the combination of independent method claim 19 and 24, it's rejected for the same reason sets forth in the rejection of claims 19 and 20 above.

As for dep. claims 26-28, 30, which basically have the same limitation as in dep. claims 20-22, and 24 above, they are rejected for the same reason set forth in the rejection of dependent claims 20-22, and 24 above.

As for dep. claim 31, which describes the specific function of first attribute and second attribute (first data and second data), wherein the first data/attribute is a price of the product, and 2nd data is different monetary values. These data or attribute are non-functional descriptive material (NFDM) and has no patentable weight. Furthermore, this is inherently taught in SKORSKI as shown in the catalog product database; par. 0003-0005.

As for independent claim 32, SKORSKI discloses a computer implemented method of returning customized information from a database in response to requests about specific tangible objects, wherein the database comprises a computer readable storage medium upon which representations of the specific tangible objects are stored, each representation comprising respective attributes of the specific tangible objects including an identifier {see figure 1-2; pars. 0019-0020}, the method comprising:

generating a first view of specific tangible objects, wherein generating the first view comprises

selecting a first set of specific tangible objects from the objects in inventory for inclusion in the first view by applying a first rule associated with the first venue to the representations of the specific tangible objects stored in the database, wherein the fist set of objects includes only those objects having identifier attributes that are in compliance with the firs rule

{see figures 1-2, at least pars. 0009-0010 wherein SKORSKI discloses different type of user access (different rules) to see/view different type/attribute of specific product depend of the user's level access into the database system. For example: "*display data (product information) according to selected criteria, and in different formats, according to the type of user that accesses information (rules). In such manner, different populations of users can access different catalogs built from the same data"*, and also

see pars. 0019, 0021 discloses representation of the specific objects stored in the database; and par. 0024, 0025, 0027 wherein SKORSKI discloses generating a first view of the object applying a first rule, and the first view includes only attributes in compliance with the first rule. For example, SKORSKI discloses *select product by product group identification* (first rule) and then by *specific products}*;

selecting one or more attributes of the representations of the first set of objects for inclusion in the first view by applying a second rule associated with the first venue to

the representations of the first set of specific tangible objects, wherein only those attributes conforming to the second rule are included in the first view

{see figures 1-2, at least pars. 0009-0010 wherein SKORSKI discloses different type of user access (different rules) to see/view different type/attribute of specific product depend of the user's level access into the database system. For example: "*display data (product information) according to selected criteria, and in different formats, according to the type of user that accesses information (rules). In such manner, different populations of users can access different catalogs built from the same data"*.

{see pars. 0024-0025, 0027-0029 SKORSKI discloses *select product by product group identification* (first rule) and then by *specific products* , and the filtering process to display the price/ for a particular product based on identification of user (second rule)

returning the first view to the first venue

{see figures 1-3, pars. 0024-0029, wherein SKORSKI discloses *the price information of other group (e.g. retailer physicians practice group) will be filtered or the retailer physician's practice will see the same item/product at different price*}.

generating a second view of the specific tangible objects, wherein generating the second view comprises

selecting a second set of specific tangible objects from the objects in inventory for inclusion in the second view by applying a third rule associated with the second venue to the same representations of the same specific tangible objects stored in the database,

see pars. 0019, 0021 discloses representation of the specific objects stored in the database; and par. 0024, 0025, wherein SKORSKI discloses generating a second view of the object applying a third rule, and the first view includes only attributes in compliance with the first rule. For example, SKORSKI discloses *select product by product group identification* (third rule) and then by *specific products*};

selecting one or more attributes of the representations of the second set of objects for inclusion in the second view by applying a fourth rule associated with the second venue to the second set of representations of the specific tangible objects, wherein only those attributes conforming to the forth rule are included in the second view, and wherein the second view differs from the first view in that at least one attribute of the representations of the specific tangible objects included in the second view is not included in the first view; and

{see figures 1-2, at least pars. 0009-0010 wherein SKORSKI discloses different type of user access (different rules) to see/view different type/attribute of specific product depend of the user's level access into the database system. For example: "*display data (product information) according to selected criteria, and in different formats, according to the type of user that accesses information (rules). In such manner, different populations of users can access different catalogs built from the same data"*.

{see pars. 0024-0025, 0028-0029 SKORSKI discloses *select product by product group identification* (third rule) and then by *specific products,* and the filtering process to display the price/ for a particular product based on identification of user (forth rule) for

example discloses when the retailer login the distributor's website, the system will display the particular product price wherein this price is different than the price that the system display for the customer (e.g. patient).

returning the second view to the second venue

{see figures 1-3, pars. 0024-0029, wherein SKORSKI discloses *The price information of other group (e.g. retailer physicians practice group) will be filtered or the retailer physician's practice will see the same item/product at different price*}.

Note that the general concept of generating a view (or display or web page) of the object based on a rule (first rule, second rule, third rule and forth rule) associated with the first venue, second venue (first user, second user) is inherently included in the teachings of SKORSKI as shown on pars. [0009, 0016, 0022-0024, and Figs. 2-3].

As for dep. claims **33-35**, which deal with basically have the same limitation as in dep. claims 20-22 above, they are rejected for the same reason set forth in the rejection of dependent claims 20-22 above.

As for dep. claim **37**, which deals with applying a multiple of rules (second rule or third rule or fourth rule) for each venue, this is inherently discloses in SKORSKI {pars. 0024, 0028}

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 23 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over SKORSKI (US 2004/0012631) in view of PORTER ET AL (US 2004/0220863).

As for dep. claims 23 and 29, SKORSKI discloses claimed invention as indicated above. SKORSKI further mentions about the customized catalogs as provided to each level of the customer {see pars. 0011, 0032}. However, SKORSKI doesn't explicitly discloses that "generating a third view comprising information regarding a plurality of tangible objects in the database for a third venue by accessing a plurality of representation of respective, specific tangible objects in the database, each representation comprising respective attribute, applying a third rule associated with the third venue to the representations, wherein the third rule excludes from the third view representation of the specific tangible object and all attributes thereof.

In the similar method of generating customer's catalog based on the set of rules, or filters associated with the customer. PORTER ET AL discloses customer's catalog is created based on the set of rules, or filters, associated with the customer {par. 0021}; the products of multiple sub-catalogs to be changed (plurality of tangible objects) merely by changing one inherited rule. For example: sub catalogs 102 and 104 from the base catalog 100 are not identical as each sub-catalog has explicit rules that are

specific to the individual catalog. The explicit rules can be based on the regions in which the catalogs are employed as well as other factor such as language compatibility or desired manufactures {pars. 0022-0023}; and also par. 0024, at least figure 3 wherein PORTER ET AL shows items (products) in state government catalog will include, or offer more items than the city government catalog, which will offer more items than the city schools catalog by using the explicit rules and inherited rules from the filters. This implies that the specific objects (items) are excludes from the view representation of the specific object and all attributes.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the method of customizing catalog base on status of customer of SKORSKI to include the features of using the rules to allows the products of multiple sub-catalogs to be changed to different levels of catalogs (some catalogs show more items than the other type of catalogs) as taught by PORTER ET AL in order to provide the users can view the particular content of catalogs that is complied with their regions, language or status.

Response to Arguments

Applicant's arguments filed on 06/24/10 have been fully considered but they are not persuasive. Amended Claims 23 and 29 have been considered but are moot in view of the new ground(s) of rejection.

In response to an argument on pages 12-15 of the remark, Applicant stated that SKORSKI fails to disclose "*selecting a first and a second plurality of attributes from the same representation in the same database*" as recited in the claims. Applicant further indicated the *custom catalogs in SKORSKI are created by "filtering" which products are selected to be included in a catalog which is not what is claimed. The claims recite using rules to select the "attributes" to be included in the first view*. However, this argument is not persuasive for the following reasons:

1) SKORSKI teaches plurality of attributes for the specific product from the same representation in the same database. For instance, SKORSKI pars. 0019, 0021-0022 shows product information (plurality of attributes for a specific object/product) are stored in a single database such as product name, product SKU numbers, one or more image files; one or more text files; search keywords; prices; taxes; shipping; sales or promotions. This product information will be viewed the same to all users except for the price (at least one attribute is different) depend on the status of users e.g. patients customer or retailer physician {see SKORSKI par. 0028-0029}. This would consider that each user can see different price, but the same product information for a particular product in the same database by applying the rule. Therefore, SKORSKI teaches the first plurality of attributes of the specific object (product information such as product name, product SKU numbers, taxes and the price for patient customer); and the second plurality of attributes of the specific object (product name, product SKU numbers, taxes, and the price for retailer physician), wherein at least one attribute (price attribute) is not included in the first plurality of attribute. It is noted that the claim only recited "at least

one attribute in the second plurality of attributes is not include in the first plurality attributes. In the other word, the first plurality attributes and the second plurality attributes are not limited to be the same except for only one attribute (e.g. price). Thus SKORSKI discloses the claimed limitation as "selecting a first and a second plurality of attributes from the same representation in the same database" as indicated above.

2) SKORSKI discloses *a database storage computer system (*a single data base) *which stores substantial indexing information regarding each of the distributor's products* (attributes); and a template server which functions as defining rules or *filtering* the retailer's web catalog {pars. 0019; 0021-0024}. It is noted that the parameters of the catalog in the template server is the parameters/information of retailer. These parameters are not attributes of the object/product information {par. 0020}. Furthermore, using a template server/database or additional database for filtering data as shows in SKORSKI does not take a way from the fact that all product data along with parameter e.g. indexing information (attributes/representation) is found in a single database as mention above. Noted that the claim language nearly called for "*generating a first view of the specific tangible object by accessing a specific representation of the tangible object in the specified database" and "generating a second view of the specific object by accessing the same representation of the same specific tangible object in the same specified database*" does not excluded using additional database to filter or process the access representation information. Thus, SKORSKI discloses the plurality of attributes of the specific tangible object is in the same database as indicated above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy-Vi Nguyen whose telephone number is 571-270-1614. The examiner can normally be reached on Monday through Thursday from 8:30 A.M to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. N./

Examiner, Art Unit 3689

/Janice A. Mooneyham/

Supervisory Patent Examiner, Art Unit 3689